

#### IV. Remarks

Reconsideration and allowance of the subject application are respectfully requested.

Claims 1-12 are pending in the application. Claims 1 and 11 are independent.

Claims 1-12 were rejected under 35 U.S. C. 112, first paragraph, for the reason noted on page two of the Office Action. Applicants respectfully traverse this rejection on the ground that the specification would readily enable a person of ordinary skill in the art to make and use the claimed invention without undue experimentation.

In more detail, the Office Action states that:

The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims. Applicants' claims must be limited to the materials provided for by their disclosure.

Applicants respectfully traverse the requirement that their claims be limited to the disclosed embodiments. It is hornbook law that claims are not to be limited to the disclosed embodiments. As stated in *In re Goffe*, 542 F.2d 564, 567, 191 USPQ 429, 431 (CCPA 1976):

To demand that the first to disclose shall limit his claims to what he has found will work or to materials which meet the guidelines specified for "preferred" materials in a process such as the one herein involved would not serve the constitutional purpose of promoting progress in the useful arts.

Any analysis of whether a particular claim is supported by the disclosure in an application requires a determination of whether that disclosure, when filed, contained sufficient information regarding the subject matter of the claims as to enable one skilled in the pertinent art to make and use the claimed invention. See *United States v. Telectronics, Inc.*, 857 F.2d 778, 785, 8 USPQ2d 1217, 1223 (Fed. Cir. 1988) ("The test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation."). A patent need not teach, and preferably omits, what is well known in the art. *In re Buchner*, 929 F.2d 660, 661, 18 USPQ2d 1331, 1332 (Fed. Cir. 1991).

In the present case, the originally-filed specification clearly teaches the person of ordinary skill in the field how to make, without undue experimentation a

flexible isocyanate-based polymeric foam which has: (i) low resiliency; (ii) a Tg less than or equal to about 0°C; and (iii) a change in tan  $\delta$  less than or equal to about 35% from a median value measured over a temperature range of from about -20° to about +60°C (Claim 1), and a flexible, low resiliency foam derived from a reaction mixture comprising: urethane-forming chemicals; water; and a plasticizer selected from the group comprising: a halogenated paraffin, a (C<sub>2</sub> /C<sub>4</sub>) aliphatic polymer comprising a primary hydroxyl group, and mixtures thereof (Claim 11). See, for example, the Examples 1-5 detailed in the specification. In fact, the full scope of the claims is enabled in exhaustive detail throughout pages 2-17 of the specification, to include the identification of commercially available constituents. The Examiner has not carried his burden of specifying how or why the person of ordinary skill in the art would not be enabled to make and use the claimed invention.

In order to make a rejection, the examiner has the initial burden to establish a reasonable basis to question the enablement provided for the claimed invention. *In re Wright*, 999 F.2d 1557, 1562, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993) (examiner must provide a reasonable explanation as to

why the scope of protection provided by a claim is not adequately enabled by the disclosure). A specification disclosure which contains a teaching of the manner and process of making and using an invention in terms which correspond in scope to those used in describing and defining the subject matter sought to be patented must be taken as being in compliance with the enablement requirement of 35 U.S.C. 112, first paragraph. See MPEP 2164.04. Applicants respectfully submit that the Examiner has not and cannot meet his initial burden.

The Federal Circuit has repeatedly held that "the specification must teach those skilled in the art how to make and use the full scope of the claimed invention without 'undue experimentation'." *In re Wright*, 999 F.2d 1557, 1561, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993). Nevertheless, not everything necessary to practice the invention need be disclosed. In fact, what is well-known is best omitted. *In re Buchner*, 929 F.2d 660, 661, 18 USPQ2d 1331, 1332 (Fed. Cir. 1991). All that is necessary is that one skilled in the art be able to practice the claimed invention, given the level of knowledge and skill in the art. Further the scope of enablement must only bear a "reasonable correlation" to

the scope of the claims. See, e.g., *In re Fisher*, 427 F.2d 833, 839, 166 USPQ 18, 24 (CCPA 1970).

As concerns the breadth of a claim relevant to enablement, the only relevant concern should be whether the scope of enablement provided to one skilled in the art by the disclosure is commensurate with the scope of protection sought by the claims. *In re Moore*, 439 F.2d 1232, 1236, 169 USPQ 236, 239 (CCPA 1971). >See also *Plant Genetic Sys., N.V. v. DeKalb Genetics Corp.*, 315 F.3d 1335, 1339, 65 USPQ2d 1452, 1455 (Fed. Cir. 2003) (alleged "pioneer status" of invention irrelevant to enablement determination). See MPEP 2164.08.

In the present case, the full scope of the claims is clearly enabled by the numerous examples, detailed technical disclosure, and careful description of how to make the claimed foam. Accordingly, it is respectfully submitted that the specification and claims are in full compliance with 35 USC 112, first paragraph.

Claims 1 - 12 were rejected under 35 U.S.C. 102(b) as being unpatentable over Farkas, Horn or Hager, for the reasons discussed on pages three and four of the Office

Action. Applicants respectfully traverse all art rejections.

Quite simply, none of the cited art (taken individually or in combination) discloses or suggests a flexible isocyanate-based polymeric foam which has: (i) low resiliency; (ii) a Tg less than or equal to about 0°C; and (iii) a change in tan  $\delta$  less than or equal to about 35% from a median value measured over a temperature range of from about -20° to about +60°C (Claim 1), and a flexible, low resiliency foam derived from a reaction mixture comprising: urethane-forming chemicals; water; and a plasticizer selected from the group comprising: a halogenated paraffin, a (C<sub>2</sub> /C<sub>4</sub>) aliphatic polymer comprising a primary hydroxyl group, and mixtures thereof (Claim 11).

The Office Action states that the claimed features are "inherent" in the cited art. However, the Examiner must provide rationale or evidence tending to show inherence. This the Examiner has not done.

Moreover, the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28

USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' " *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted). **"In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art."** *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original). See MPEP 2112.

Applicants submit that the Examiner has not met his burden, nor can his burden be met for the simple reason

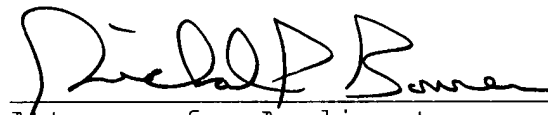
that the cited art is devoid of teachings anticipating or rendering obvious the claimed invention.

In view of the above amendments and remarks, it is believed that this application is now in condition for allowance, and a Notice thereof is respectfully requested.



Applicants' undersigned attorney may be reached in  
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All correspondence should continue to be directed to our  
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Respectfully submitted,



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